IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent application of	:	
Gi-Young YANG et al.	:	Group Art Unit 2829
Application No. 10/784,784	:	Examiner Jermele M. HOLLINGTON
Filed 24 February 2004	:	

METHOD OF MEASURING GATE CAPACITANCE BY CORRECTING DISSIPATION FACTOR ERROR

Petition Under 37 C.F.R. §1.181 to Withdraw Improper Holding of Abandonment And in the Alternative Petition Under 37 C.F.R. §1.137(b) for Revival of an Application Abandoned Unintentionally

U.S. Patent and Trademark Office
Customer Service Window, **Mail Stop Petition**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Notice of Abandonment dated 20 September 2006 in connection with the above-referenced U.S. patent application, Applicants hereby submit this "Petition under 37 C.F.R. § 1.181(a) to Withdraw an Improper Holding of Abandonment."

In the event that the "Petition under 37 C.F.R. § 1.181 for Withdrawal of the Holding of Abandonment" is denied, Applicants concurrently submit this "Petition Under 37 C.F.R. §1.137(b) for Revival of an Application Abandoned Unintentionally."

The Commissioner is hereby authorized to charge payment to Deposit Account No. 50-0238 for any and all Petition Fee(s) required for these Petitions, specifically including any fees required under 37 C.F.R. §§ 1.137(b), 1.181(a), and 1.17(m).

Petition under 37 C.F.R. § 1.181(a)

To Withdraw an Improper Holding of abandonment

In the Notice of Allowance and Notice of Allowability dated 12 May 2006, the Examiner made an Amendment *sua sponte* to FIG. 1 to add a label "PRIOR ART", and also to add a new heading into the middle of Applicants' specification. This "amendment" was made without any approval by Applicants or Applicants' representative, the undersigned attorney – and indeed without any effort by the Examiner to even attempt to discuss the proposed "amendment" with Applicants or their representative. In conjunction with this "amendment" the Examiner also stated that Applicants ***must*** file corrected drawings.

Applicants duly paid the Issue Fee by the Due Date on 9 August 2006 (copy of date-stamped postcard attached), before the Due Date of 14 August 2006, but did not file any new drawings.

Subsequently, on 20 September 2006 the Examiner issued a "Notice of Abandonment" for the application, stating that Applicants failure to submit any new drawing caused the application to go abandoned.

Applicants respectfully submit that the attempt by the Examiner to amend Applicant's application in a supposed-Notice of Allowance – without any approval by Applicants or their representative – lacks any legal authority under the statutes, rules, or case law and is therefore of null effect. Similarly, Applicants also respectfully submit that the corresponding "requirement" of the Examiner – again in a supposed-Notice of Allowance - that Applicants submit an amended drawing lacks any legal authority under the statutes, rules, or case law and is therefore of null effect. Therefore, Applicants also respectfully submit that the Holding of Abandonment for failing to submit an amended drawing is improper, being based on an improper Examiner's Amendment without Applicant's approval that lacks any authority under the statutes, rules, or case law.

At the outset, 37 C.F.R. § 1.311, "Notice of Allowance" reads in pertinent part:

"***(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant*** at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable."

(Emphasis added).

There is no authority in the statutes, Patent Office rules, or case law for issuing a Notice of Allowance and requiring Applicants to do anything other than to pay the Issue Fee, or correct drawing objections under 37 C.F.R. § 1.85. Here, Applicants respectfully submit that 37 C.F.R. § 1.85 does not apply. The drawing was not objected to under 37 C.F.R. § 1.85 – in fact, neither 37 C.F.R. § 1.84 nor 37 C.F.R. § 1.85 was cited anywhere in the "Notice of Allowability." A new drawing was "required" solely on the basis of an Examiner's Amendment for which there was no legal basis under the statutes, rules, or case law and which is therefore of null effect.

Indeed, although the M.P.E.P. is not in and of itself binding on Applicants, Applicants respectfully submit that it does provide guidelines for the examination of application by patent examiners. In that regard, Applicants respectfully submit that not only did the Examiner's Amendment have no legal basis under the statutes, rules, or case law, it was also directly contrary to M.P.E.P § 1302.04. For Example, the Examiner's Amendment attempted to add a new heading above paragraph [0016] in the Specification entitled "Summary Of The Invention," – supposedly "*in order to separate what is*

admitted prior art and the applicant's invention." However, such an Examiner's Amendment is very clearly forbidden by M.P.E.P § 1302.04 which states:

> "No examiner's amendment, whether formal or informal, may make substantive changes to the written portions of the specification, including the abstract, without first obtaining applicant's approval."

No approval was given, or even sought, here! And regardless of the M.P.E.P., it is very clearly not within the province of the Examiner, and it is completely improper, for the Examiner to expropriate the authority unto himself to attempt to label what is "admitted prior art" from "applicants' invention!" Applicants strenuously object to this misappropriation of authority to attempt to characterize portions of the disclosure as "prior art" which have not been so explicitly identified in that way by Applicants.

Furthermore, there is a very clear procedure authorized under case law for an Examiner to follow when the claims are deemed to be in condition for allowance, but there are other formal matters to which the Examiner objects. It is called an ***Ex Parte Quayle*** action (see M.P.E.P. §§ 706.07(f)(III) and 714.14). Here, if the Examiner objected to the drawings or specification as including a substantive deficiency, the proper course of action – and the only course of action with a legal basis under the statutes, rules, or case law – would be to issue an ***Ex Parte Quayle*** action.

Accordingly, Applicants respectfully request that the Holding of Abandonment for this application be withdrawn, the Examiner's Amendments be withdrawn, and the application be passed to issue.

Petition Under 37 C.F.R. §1.137(b)

For Revival of an Application Abandoned Unintentionally

Applicants respectfully believe that the foregoing Petition under 37 C.F.R. §

1.181(a) to withdraw an improper holding of abandonment should be granted. However, in the event that the Petition under 37 C.F.R. § 1.181(a) is denied, Applicants respectfully request and Petition concurrently under 37 C.F.R. § 1.137(b) or revival of the application as having been unintentionally abandoned.

The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR § 1.137(b) was unintentional.

Applicants also submit herewith below a Response to the Examiner's Amendment included in the Notice of Allowability.

RESPONSE TO NOTICE OF ALLOWABILITY

Applicants respectfully do not believe that there is any requirement to label FIG.1 as "Prior Art." The "Notice of Allowability" does not indicate any basis upon which the Examiner requires that Figure 1 be labeled "prior art." In this regard, it is noted that items may be conventional to an Applicant, but not "prior art" under 35 U.S.C. § 102. For example, internal test procedures that have been used in the past by an Applicant's assignee to test a semiconductor within its factory may be "conventional" procedures, but this does not make them "prior art" under 35 U.S.C. § 102 unless they are publicly known or disclosed. Indeed, in such cases many times it is impossible for Applicants to know precisely whether such procedures have been publicly known by others, and therefore whether or not they truly constitute "prior art," or whether they are merely "conventional" to Applicant. For this reason, Applicants may choose to identify portions of a patent specification as disclosing "conventional" subject matter – to distinguish those portions from the subject matter of the invention to be claimed – without stating (perhaps incorrectly) that it is "prior art."

Therefore, for at least these reasons, Applicants respectfully submit that the Examiner's requirement in the "Notice of Allowability" that Applicants label FIG. 1 as "prior art" is respectfully objected to and traversed.

AMENDED FIG. 1

In the event that the foregoing arguments are not deemed to comprise a timely, complete, and acceptable Response to the "Notice of Allowability" sufficient to meet the requirements for this Petition under 37 CFR § 1.137(b), and out of an abundance of caution only, Applicants also submit herewith an Amended FIG. 1. Applicants authorize the Patent Office to accept and enter into the application this amended FIG. 1 only in the event that the above "Response to Notice of Allowability" is not deemed to comprise a timely, complete, and acceptable Response to the "Notice of Allowance" sufficient to meet the requirements for this Petition under 37 CFR § 1.137(b), such that the amended Drawing is necessary to comply with 37 CFR § 1.137(b) and revive the application.

CONCLUSION

In the event that there are any outstanding matters remaining in the present application, the Patent Office is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283-0720 to discuss these matters.

Respectfully submitted,

VOLENTINE FRANCOS & WHITT, P.L.L.C.

Date: 14 November 2006

By: _____
Kenneth D. Springer
Registration No. 39,843

VOLENTINE FRANCOS & WHITT, P.L.L.C.
One Freedom Square
Suite 1260
11951 Freedom Drive
Reston, Virginia 20190
Telephone No.: (571) 283-0720
Facsimile No.: (571) 283-0740